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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,892	10/23/2001	Kevin Burns	CNTW-015/00US	6845

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EXAMINER

NELSON, FREDA ANN

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,892

Applicant(s)

BURNS ET AL.

Examiner

Freda A. Nelson

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is in response to a letter for a patent filed on October 23, 2001 in which claims 1-29 were presented for examination. Claims 1-29 are pending.

#### ***Information Disclosure Statement***

1. The information disclosure statements (IDSs) submitted on 04/17/2002, 03/05/2004, 03/31/05 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner. Copies of PTO-1449s are attached hereto.

#### ***Claim Objections***

2. Claim 25 is objected to because of the following informalities:  
As for claim 25, line 3, "PRM" should be "PMR".  
Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 9, 11-12, 17-18 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for claims 1 and 28, the examiner is unable to determine how the system evaluates a network management tool.

Claim 9 recites the limitation "PMR cost" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 11-12 and 26-27, respectively, recite the limitation "CMR cost" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-18 recite the limitation "SLA/downtime cost" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "PRM cost" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 6-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 6-27, the invention, as defined by the claims and as best understood merely manipulate an abstract idea or perform a purely mathematical algorithm with no useful purpose, as nothing is done with the result or a result cannot be determined, assured or reproducible, or a result cannot be repeated. The invention does not require physical acts to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts

involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure. See *Diamond v. Diehr*, 450 US at 187, 209 USPQ at 8. The steps of calculating a total cost of ownership for a communications network does not impose independent limitations on the scope of the claim beyond those required by the mathematical operation and abstract limitations because the calculated cost values are not actual measured values of physical phenomena. *In re Galnovatch*, 595 F.2d at 41 n.7, 201 USPQ at 145 n.7; *In re Sarker*, 588 F.2d at 1331, 200 USPQ at 135. The steps of “calculating” have no direct effect on the physical world outside the computer. Thus, the claimed invention merely inputs data into the system and performs a mathematical algorithm without any limitation to a practical application as a result of the algorithm or outcome and is therefore deemed to be non-statutory.

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete

and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack

of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including calculating a total cost of ownership for a communications network without any useful, concrete and tangible result and are therefore deemed to be non-statutory. While these numbers may be concrete and/or tangible, there does not appear to be any useful result.

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-5 and 28-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Menard et al. (US PG Pub. 2002/0173997).

As for claim 1, Menard et al. disclose a system and method for business systems transactions and infrastructure management includes a client side collection system and a server side system having the capability to communicate with the other over a secure communication path (abstract); the management server may comprise a data processor for performing complex calculations (paragraph [0013]); and the data processor 420 performs calculations on raw data received from the collection system (paragraph [0041]).

Menard et al. do not disclose a configuration management request (CMR) cost calculator; a problem management request (PMR) cost calculator; a service creation accelerated revenue (SCAR) cost calculator; and an evaluator in communication with the CMR cost calculator, the PMR cost calculator, and the SCAR cost calculator, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1 including a cost calculator are disclosed in

Art Unit: 3639

Menard et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

As for claims 2-5, Menard et al. disclose that the management server 40 logically groups software that combines, correlates, and analyzes data that the collections system extracts from the client business system (paragraph [0037]; FIG. 4); a system and method for business systems transactions and infrastructure management includes a client side collection system and a server side system having the capability to communicate with the other over a secure communication path (abstract); the management server may comprise a data processor for performing complex calculations (paragraph [0013]); and the data processor 420 performs calculations on raw data received from the collection system (paragraph [0041]).

Menard et al. do not disclose a configuration management software calculator, wherein the evaluator is in communication with the configuration management software calculator; an internal communication cost calculator, wherein the evaluator is in communication with the internal communication cost calculator; an SLA/downtime cost calculator, wherein the evaluator is in communication with the SLA/downtime cost calculator; and wherein CMR evaluator comprises: an adjusted CMR cost calculator, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 2-5 including a cost calculator are disclosed in Menard et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

As for claims 28-29, Menard et al. disclose a system and method for business systems transactions and infrastructure management includes a client side collection system and a server side system having the capability to communicate with the other over a secure communication path (abstract); the management server may comprise a data processor for performing complex calculations (paragraph [0013]); and the data processor 420 performs calculations on raw data received from the collection system (paragraph [0041]).

Menard et al. do not disclose a means for calculating a total cost of ownership for a communication network; means for calculating a potential cost avoidance realizable through the network management tool; means for determining an evaluation factor for the network management tool, wherein the evaluation factor corresponds to the total cost of ownership and the potential cost avoidance; and means for calculating a potential service creation accelerated revenue realizable through the network management tool.; however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the



Art Unit: 3639

manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 28 including a means for calculating a cost are disclosed in Menard et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Conclusion***

The examiner has cited prior art of interest, for example:

1) Bonabeau (US PG Pub. 2001/0053991), which disclose methods and systems for generating business models.

2) Cepeda (US PG Pub. 2002/0069143), which disclose a system and method for allocating operating expenses.

3) Smorodinsky et al. (Patent Number 6,453,255), which disclose a method for complex products configuration and guarantee generation.

4) Willems et al (US PG Pub. 2002/0072956), which disclose a system and method for determining the optimum configuration strategy for systems with multiple decision options.

### ***Conclusion***

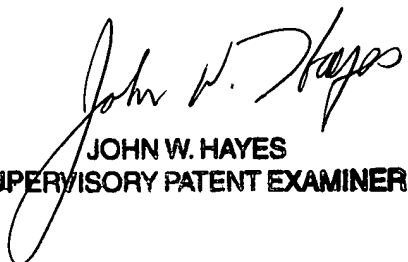
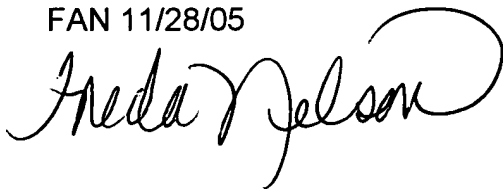
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

Art Unit: 3639

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 11/28/05



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER